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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tetsuya KANEMARU et al.
Title: SILICONE-TREATED POWDER,
PROCESS OF PRODUCTION
THEREOF AND COMPOSITION
CONTAINING THE SAME
Patent No. 7,449,193
Issued: 11/11/2008
Appl. No.: 10/679,298
Filing Date: 10/7/2003
Examiner: Bethany P. BARHAM
Art Unit: 1615
Conf. No.: 3585

REQUEST FOR RECONSIDERATION OF PTA DECISION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the Decision dated July 2, 2010 (hereinafter "Decision"). A fee was submitted with the original request for reconsideration of Patent Term Adjustment (PTA) of January 5, 2009. If a request for reconsideration is not appropriate, then this present request is a petition under 37 CFR sections 1.181, 1.182, and 1.183.

With the Decision mailed on July 2, 2010, the Patent Office determined that the patent was entitled to 84 days of PTA. The present Request for Reconsideration is timely filed within one (1) month from the decision.

Applicants have calculated PTA for the captioned patent, and have determined that the patent is entitled to 157 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	458 days
(b) Total Applicant delay:	301 days
Final PTA Determination:	157 days

Applicants believe the amount of “A” delay is 103 days, and not 101 days as calculated by the US PTO, as shown on the attached calculation sheet.

Applicants believe the PTO’s position of counting all days between the filing of a Notice of Appeal on July 3, 2006 and the mailing of a non-final rejection on September 11, 2006 under 37 CFR 1.703(b)(4) is not proper. 37 CFR 1.703(b)(4) interprets 35 USC 154(b)(1)(B)(ii), which provides that the guarantee of no more than 3-year pendency does not include “any time consumed by appellate review by the Board.” 37 CFR 1.702(b)(4) contains parallel language. Although 37 CFR 1.703(b)(4) appears to implement these provision by counting the number of days “beginning on the date on which a notice of appeal to the Board . . . was filed,” this rule over counts days, because the filing of a notice of appeal does not commence the time period of appellate review by the Board. To the contrary, as set forth in 37 CFR 41.35, jurisdiction does not pass to the Board until after all briefs and the examiner’s answer have been issued, at which time the Technology Center transmits the file to the Board. Until then, there is no “appellate review by the Board,” and the examiner maintains jurisdiction, for example, to reopen prosecution or issue a notice of allowance.

In this application, there was no appellate review by the Board; indeed, no Brief on Appeal was ever filed. The notice of appeal was filed to maintain pendency while the examiner considered Applicants’ concurrently filed response, and the next action was the non-final rejection mailed on September 11, 2006. Thus, the 71 day period between the filing of a Notice of Appeal on July 3, 2006, and the issuance of a non-final rejection on September 11, 2006, was in no way related to appellate review by the Board, and so 35 USC 154(b)(1)(B)(ii) does not justify excluding these days from the 3-year pendency calculation.

35 USC 154(b)(1)(B)(ii) provides for patent term adjustment when issuance is delayed due to "appellate review by the Board . . . in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." Because there was no appellate review, let alone a reversal of a rejection, this statute is inapplicable here.

Applicants therefore respectfully request that the patent be accorded 157 days PTA.

The patent is not subject to a terminal disclaimer.


It is believed no fees are due for the present filing. Any deficiency in fees may be charged to Deposit Account 19-0741.

Respectfully submitted,

Date JUL 29 2010

By  Ry # 59,349

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 053466-0372
 Application Number: 10/679298
 Patent Number: 7449193



	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	10/07/2003	0		
	14 month From Application date	12/07/2004	427		
Edit Delete	Restriction Requirement	03/11/2005	521	94	
Edit Delete	Restriction Requirement Response Received at PTO	04/08/2005	549		
Edit Delete	Non-Final Office Action	04/27/2005	568		
	Non-Final Office Action + 3 months	07/27/2005	659		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/27/2005	751		92
Edit Delete	Final Office Action	02/02/2006	849		
CLOSE WINDOW	ALL CASES SELECT CASE				
	Final Office Action + 3 months	05/02/2006	938		
Edit Delete	Notice of Appeal Received at PTO	07/03/2006	1,000		62
Edit Delete	Final Office Action Response Received at PTO	07/03/2006	1,000		
Edit Delete	Non-Final Office Action	09/11/2006	1,070		
	3 Year Period Starts	10/07/2006	1,096		
	Non-Final Office Action + 3 months	12/11/2006	1,161		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/09/2007	1,249		88
Edit Delete	Final Office Action	05/29/2007	1,330		
	Final Office Action + 3 months	08/29/2007	1,422		
	3 Year Period Stopped	09/27/2007	1,451	355	
Edit Delete	Request For Continued Examination (including amendment)	09/28/2007	1,452		30
Edit Delete	Non-Final Office Action	10/31/2007	1,485		
	Non-Final Office Action + 3 months	01/31/2008	1,577		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/29/2008	1,606		29
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	06/29/2008	1,727		
Edit Delete	Notice of Allowance	07/08/2008	1,736	9	
Edit Delete	Issue Fee Paid	10/07/2008	1,827		
Edit Delete	Patent Grant Date	11/11/2008	1,862		

Totals: 458 301
PTA: 157



Version: 3.02.09

LOGIN: Karen Walker

IP: 10.14.41.156

Foley & Lardner LLP